

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

el

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/103,110	06/23/98	ESKILDSEN	S 042390.P5444

MM22/0217
BLAKELY SOKOLOFF TAYLOR AND ZAFMAN
12400 WILSHIRE BLVD
7TH FLOOR
LOS ANGELES CA 90025

EXAMINER	
DINH, T ART UNIT	PAPER NUMBER

2835
DATE MAILED:
02/17/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)
	09/103,110	ESKILDSEN ET AL.
Examiner	Art Unit	
Tuan T Dinh	2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

1) Responsive to communication(s) filed on 23 June 1998 .

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-14 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-14 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:
1. received.
2. received in Application No. (Series Code / Serial Number) _____.
3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

14) Notice of References Cited (PTO-892) 17) Interview Summary (PTO-413) Paper No(s). _____
15) Notice of Draftsperson's Patent Drawing Review (PTO-948) 18) Notice of Informal Patent Application (PTO-152)
16) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2 19) Other: _____

Art Unit: 2835

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Because the data processing device is a function and not an element or any structure in the claim, suggest change "IC card for use ⁱⁿ ~~with~~ data processing device" to IC card including a processing device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 7-10, and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ramey et al (U. S. Patent 5,476,387)

As to claims 1, 7, and 13-14, Ramey discloses an IC card and a method as shown in figures 1-8 comprising an IC package (16) having multiple leads (shown in figure 1) and a casing (10, 11) (column 2, lines 40-45).

Art Unit: 2835

As to claims 2-4, 8-10, Ramey discloses an IC card and a method as shown in figure 1 wherein a casing that has a front and back surfaces, and each surface has an opening. Also, the back surface has at least one stop to (18) hold IC package securely within a casing (column 2, lines 45-60).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5-6, 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramey et al (U. S. Patent 5,476,387) in view of Ochi et al (U. S. Patent 5,735,040)

As to claims 5-6 and 11-12, Ramey discloses an IC card and method and satisfies all of the limitation of the claims, except for the IC card wherein the casing having the bottom surface that has a bottom opening, and the casing has at least one stop at the bottom opening. Ochi shows the IC card (10) having the casing that has the bottom surface including the opening (2a), the casing has at least one stop (20) (column 3, line 65-67, column 4, lines 1-4). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the IC card assembly of Ramey and provide the casing of the IC card that has bottom surface including an opening and stop to hold the IC package as taught by Ochi.

Art Unit: 2835

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kodai et al, Ohtsuki, Benjo et al, disclose related art
12. Any inquiry concerning this communication or earlier communications from the examiner should be direct to Tuan Dinh whose telephone number is (703) 306-5856 or fax number (703) 305-3431. If attempts to reach the above noted examiner by telephone are unsuccessful, the examiner 's supervisor, Mr. Leo P. Picard can be reached at (703) 308-0538.

Tuan Dinh

February, 2000

A handwritten signature in black ink, appearing to read "Tuan Dinh". The signature is written in a cursive style with a horizontal line through the end of the name.